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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/376,860	08/18/1999	HENRICUS A. W. VAN GESTEL	PHN-17.070	7043

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EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/24/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/376,860

Applicant(s)

VAN GESTEL ET AL.

Examiner

Jinsong Hu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

1. Claims 1-6 are presented for examination.
2. The attempt to incorporate subject matter into the specification by referencing to claims 1-6 (see specification pages 1-3) is improper because the specification is supposed to describe invention in narrative English, not by cross referencing the claims. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52 (a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.
3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show texts or labels in all the boxes of Fig. 1-2 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. See MPEP 608.02(d). Correction is required.
4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. The claim language in the following claims is not clearly understood.
 - i. As per claims 1-6, the use of word "characterized" is inappropriate since 35 USC § 112, second paragraph, requires the claim to particularly point out and distinctly claim the invention, not merely its characteristics. Furthermore, if this

word is eliminated, then the remaining format of claim should be modified in order to reflect this correction. Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman et al. (WO 97/22062).

7. Huffman et al. (WO 97/22062) is a prior art reference cited on form 1449 by applicant dated 1/21/00.

8. As per claim 1, Huffman teaches the invention as claimed including an information processing device [col. 3, lines 3-5; col. 10, lines 13-18] including storage means for storing units [136, Fig. 2; col. 10, lines 24-29] of primary information [col. 8, lines 10-12], and user operable means for making selections [412, 414, etc., Fig. 25] from the units of primary information to be processed [col. 10, lines 19-23] and/or from functions to be invoked [col. 13, lines 12-18], the device also includes further storage means [746, Fig. 38], and personalizing means for deriving personalizing information

[col. 37, lines 9-10] from said selections in order to store the personalizing information in the further storage means [col. 37, lines 7-23].

9. As per claim 2, Huffman teaches that the personalizing means are arranged to maintain a link between a respective unit [760, Fig. 39] of said primary information and a respective unit [768, Fig. 39] of the personalizing information [col. 37, line 32 – col. 38, lines 3].

10. As per claim 3, Huffman teaches that the device includes presentation means for presenting information [764, Fig. 39], the personalizing means being arranged to present a respective unit of personalizing information which is linked to a respective unit of primary information while the respective unit of primary information is being processed [col. 37, line 24-col. 38, line3].

11. As per claim 5, Huffman teaches that the device including communication means for exchanging units of primary information with a similar device [col. 9, lines 9-17], the personalizing means are arranged to attach a personal tag [bookmark] to a unit of primary information [col. 13, lines 26-33] to be sent to the similar device [col. 9, lines 9-17], the personalizing means also being arranged to detach a personal tag from a received unit of primary information [inherent in Huffman's system] and store it as personalizing information in the further storage means [col. 13, lines 12-14].

12. As per claim 6, since it is a method claim of claim 1, it is rejected under the same basis as claim 1.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Huffman et al. (WO 97/22062).

15. As per claim 4, Huffman teaches the invention substantially as claimed in claim 1. Huffman does not specifically teach the step of erasing a respective unit of primary information in response to a user command. It would have been obvious to a person of ordinary skill in the art at the time the invention was made that including a erasing function in Huffman's system because doing so would give users option to delete the information they do not want to store in the memory. One of ordinary skill in the art would have been motivated to modify Huffman's system in order to save storage space.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Morita et al. (US 6,354,939 B1) discloses a game processing system; and

Yamamoto et al. (5,265,888) discloses a game and memory system.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follow:

Official Faxes: (703) 746-7239


After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

September 11, 2002


ZARNI MAUNG
PRIMARY EXAMINER